

## REMARKS

Claims 6-8 and 11 have been canceled herein. Claims 1-5 and 9-10 have been amended herein. New claims 12-14 have been added herein. Therefore, claims 1-5, 9-10 and 12-14 are pending and under active consideration.

The Patent Office states the following as a preliminary matter in the outstanding Office Action:

Applicants' claim that this application is a 371 of PCT/DE00/03441, which claims priority to GERMANY 199 47 440.0, is acknowledged. However, the priority to GERMANY 199 47 440.0 has not been perfected, as a copy of the certified document has not been received.

In response to the foregoing matter, Applicants are submitting herewith a certified copy of the aforementioned German priority document. In view of the above, it is respectfully submitted that the foreign priority claim has now been perfected. Accordingly, Applicants respectfully request that the Patent Office indicate, in its next correspondence, that perfection of the foreign priority claim has been achieved.

Claims 8-11 stand rejected under 35 U.S.C. 101 "because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex Parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F.Supp. 131, 149 USPQ 475 (D.D.C. 1966)."

Insofar as the foregoing rejection pertains to claims 8 and 11, the rejection is moot in view of Applicants' cancellation herein of claims 8 and 11. Insofar as the foregoing rejection pertains to

claims 9 and 10, Applicants respectfully submit that the rejection has been overcome by Applicants, who have rewritten claims 9 and 10 so that they now recite a proper method, instead of a use.

Accordingly, for at least the above reasons, the foregoing rejection should be withdrawn.

Claims 1-6 and 8-11<sup>1</sup> stand rejected under 35 U.S.C. 112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." With respect to claims 1-4 and 6, the Patent Office states the following:

The R moiety in claim 1 is defined as an organic "residue". This definition renders the aforementioned claims indefinite because, R includes "a single bond" (see claims 2 and 3). The accepted meaning of residue is "a material that remains after any procedure to remove something". Consequently, to an ordinary skilled artisan, the term residue would be understood to include some remainder rather than no remainder at all, which would be the case when R is a 'single bond'. Thus, the term "residue" in claim 1 is confusing and renders the claim indefinite.

With respect to claims 8-11, the Patent Office states the following:

Claims 8-11 provide for the use of specific compounds claimed, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

With respect to claim 5, the Patent Office states the following:

Claim 5 is rejected as being in improper Markush format. MPEP 2173.05(h): I Markush Groups: Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as Markush

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<sup>1</sup> Although the statement of rejected claims in the Office Action lists only claims 1-4 and 6, it appears, based on the grounds given in support of the rejection, that claims 5 and 8-11 are included in this rejection as well.

group, recites members as being "selected from the group consisting of A, B and C." Ex parte Markush, 1925 C.D. 126 (Comm'r Pat. 1925). The claim recites compounds according to claim 1, "namely"...The use of this phrase renders the claim ambiguous, as it is unclear whether the Applicant is claiming all the compounds listed in claim 5 or a compound selected from the group of compounds in claim 5. In this regard, the term "namely" is not an acceptable form of alternative expression and thus this claim is in improper Markush format.

Insofar as the foregoing rejection pertains to claims 6, 8 and 11, the rejection is moot in view of Applicants' cancellation herein of claims 6, 8 and 11. Insofar as the foregoing rejection pertains to claims 1-5 and 9-10, Applicants respectfully traverse.

With respect to claims 1-4, Applicants have amended claims 1 and 2 so that they no longer recite the word "residue."

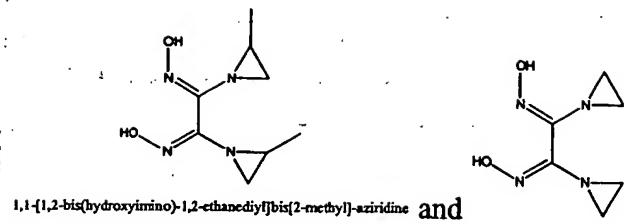
With respect to claim 5, Applicants have replaced the word "namely" with appropriate Markush language.

With respect to claims 9-10, Applicants have rewritten the claims so that they now recite a proper method.

Accordingly, for at least the above reasons, the foregoing rejection should be withdrawn.

Claims 1-3, 6 and 7 stand rejected under 35 U.S.C. 102(b) "as being anticipated by Eremeev, et al." In support of the rejection, the Patent Office states the following:

Applicants claims relate to arizidine-1-hydroxymethyl compounds of formula I in claims 1-3 and 7 and a process of preparing these compounds as claimed in claim 6. Eremeev, et al disclose compounds that anticipate the instantly claimed genus (i) where n is 2, R is a single bond and R1 and R2 are hydrogen, and (ii) where either one of R1 or R2 is methyl, while the other is hydrogen, n is 2 and R is a single bond. See below for representation of the specific species.

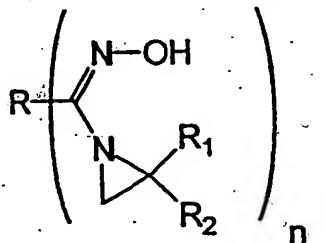


See Formula IV and Formula IX in reference on page 369.

Also, the reference discloses the process of preparing these species that anticipates the instant claim 6, wherein dihaloglyoxime is reacted with an appropriately substituted aziridine to produce the species as depicted supra. See scheme I in reference on page 369, wherein the R moiety on the dihaloglyoximes is chloro and the R<sub>2</sub> and R<sub>3</sub> substituents on the aziridine ring as those indicated for Formula IV and IX.

Insofar as the foregoing rejection pertains to claims 6 and 7, the rejection is moot in view of Applicants' cancellation herein of claims 6 and 7. Insofar as the foregoing rejection pertains to claims 1-3, Applicants respectfully traverse the foregoing rejection.

Claim 1, from which claims 2-3 depend, has been amended herein and now recites "1-Aziridino-1-hydroxyiminomethyl derivatives of the formula I



wherein

I

R is selected from the group consisting of a single bond and a linker moiety capable of bonding covalently two aziridine oxime groups,

R<sub>1</sub> and R<sub>2</sub> independently of one another are selected from the group consisting of -H, -CH<sub>3</sub>, -C<sub>2</sub>H<sub>5</sub>, -CN, -COOH, -COOCH<sub>3</sub>, -COOC<sub>2</sub>H<sub>5</sub>, -CONH<sub>2</sub>, or -C<sub>6</sub>H<sub>5</sub> group, provided that R<sub>1</sub> and R<sub>2</sub> are not both -H and provided that R<sub>1</sub> is not -H if R<sub>2</sub> is -CH<sub>3</sub> and R<sub>1</sub> is not -CH<sub>3</sub> if R<sub>2</sub> is -H, and

n is 2."

Thus amended, claim 1 is neither anticipated by nor rendered obvious over Eremeev et al. for at least the reason that Eremeev et al. does not teach or suggest compounds of the type claimed in claim 1. More specifically, the compounds allegedly disclosed by Eremeev et al. wherein n is 2, R is a single bond, and R<sub>1</sub> and R<sub>2</sub> are both hydrogen or one of R<sub>1</sub> and R<sub>2</sub> is hydrogen and the other of R<sub>1</sub> and R<sub>2</sub> is methyl are no longer recited in claim 1.

Accordingly, for at least the above reasons, the foregoing rejection should be withdrawn.

Claim 7 stands objected to under 37 CFR 1.75 "as being a substantial duplicate of any one of claims 1-6." In view of Applicants' cancellation herein of claim 7, the rejection is moot and should be withdrawn.

Applicants note that claims 4-5 and 9-10 have not been rejected on the basis of any prior art, but rather, have been rejected solely for non-art reasons. In view of the fact that Applicants have overcome said non-art reasons, the immediate allowance of claims 4-5 and 9-10 appears to be warranted.

New claims 12-13 depend from claim 2, and new claim 14 depends from claim 3. As noted above, claims 2 and 3 are patentable. Therefore, claims 12-14 are also patentable based at least on their respective dependencies from claims 2 and 3. No new matter is added by claims 12-14.

In conclusion, it is respectfully submitted that the present application is now in condition for allowance. Prompt and favorable action is earnestly solicited.

If there are any fees due in connection with the filing of this paper that are not accounted for, the Examiner is authorized to charge the fees to our Deposit Account No. 11-1755. If a fee is

required for an extension of time under 37 C.F.R. 1.136 that is not accounted for already, such an extension of time is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 29, 2004

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Dated: March 29, 2004